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ATTORNEY DOCKET NO. 03225.0001U2  
APPLICATION SERIAL NO. 10/650,260

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of )  
Poynard ) Art Unit: 1631  
Application No. 10/650,260 ) Examiner: John S. Brusca  
Filing Date: August 27, 2003 ) Confirmation No. 7184  
For: DIAGNOSIS METHOD OF INFLAMMATORY, )  
FIBROTIC OR CANCEROUS DISEASE )  
USING BIOCHEMICAL MARKERS )

ELECTION UNDER RESTRICTION REQUIREMENT

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

NEEDLE & ROSENBERG, P.C.  
Customer Number 23859

Sir:

This is in response to the Office Action issued February 27, 2006, wherein restriction of the claims of the above-referenced application is required.

The Office Action requires designation of each of the three sets of species as follows:

- A. The first set of species** comprises species of diseases or conditions that are detected by the method, as claimed in claims 20, and 29-35. The diagnostic kit of claim 36 will be examined for the elected species of disease or condition.
- B. The second set of species** comprises species of markers consisting of
  - 1) a set of four markers as claimed in claim 23, or
  - 2) the set of 6 markers as claimed in claim 25, or
  - 3) the set of 5 markers as claimed in claim 26.

C. **The third set of species** comprises species of logistic function selected from:

- 1) one of the five functions of claim 27, or
- 2) one of the 6 functions of claim 28.

Applicant is required to elect a single disclosed species from each of the three sets of species, resulting in an election of one species from each set.

In response, applicants provisionally elect from the first set of species the fibrotic diseases (liver fibrosis), corresponding to claim 33; from the second set of species, the set of six (6) markers, as claimed in claim 25; and from the third set of species, one of the five functions of claim 27, with traverse. Applicants believe that claims 20, 21, 22, 24, 25, 27, and 29-36 read on the elected species consistent with this requirement.

Applicants further request that the restriction requirement be reconsidered because the Examiner has not shown that a serious burden would be required to examine all the claims. M.P.E.P. § 803 provides:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Thus, for a restriction requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121); and (2) the search and examination of the entire application cannot be made without serious burden. See M.P.E.P. § 803.

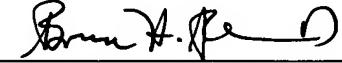
In particular, the Examiner has not shown that the second requirement has been met. Specifically, the Examiner has not shown that it would be a serious burden to search and

examine the groups together. Because little or no additional burden would be required to search and examine the groups together, applicants respectfully submit that the groups should be searched and examined together. For these reasons, reconsideration and withdrawal of the restriction requirement are requested.

For the reasons stated above, applicants respectfully assert that restriction of the claims as set forth by the Examiner would be contrary to promoting efficiency, economy and expediency in the U.S. Patent and Trademark Office (PTO), and further point out that restriction by the Examiner is discretionary (M.P.E.P. § 803.01). Consequently, reconsideration and withdrawal or modification of the restriction requirement is requested.

No fee is believed due; however, the Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,  
NEEDLE & ROSENBERG, P.C.

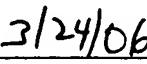
  
Bruce H. Becker, M.D., J.D.  
Registration No. 48,884

NEEDLE & ROSENBERG, P.C.  
Customer Number 23859  
(678) 420-9300  
(678) 420-9301 (fax)

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

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Bruce H. Becker, M.D., J.D.

  
Date